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IN THE

Supreme Court of the United States

OCTOBER TERM, 1957.

No. 335

SOLAR CORPORATION, BY MERGER NOW GAMBLE-SKOGMO, INC.,

Petitioner,

vs.

BORG-WARNER CORPORATION,

Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

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FOREWORD.

Respondent has no difference with Petitioner's preliminary statement in the Petition (p. 1), and concedes jurisdiction.

Respondent denies that the "Questions Presented" stated in the Petition (p. 2) are present in the case.

RESPONDENT'S STATEMENT OF THE CASE.

None of the Grounds Prescribed by Rule 19 as Governing Reviews on Certiorari Are Present in the Case.

This is merely another patent case in which the Petitioner, Plaintiff below, seeks a hearing by this Court of conventional patent questions.

Petitioner brought suit on its Castner patent (original and Reissue; App. 446-459) and its Roth patent (now discarded) charging infringement by Respondent's manufacture of washing machines. The Castner patent covered a specific form of open annular sediment trap in the washing machine bottom. Sediment traps of different forms in washing machine bottoms were old (Dunham patent, App. 471; Dyer patent, App. 562).

The judgment below held claim 1, which was conceded to be infringed if valid, directly anticipated by Dunham (Finding 18, App. 23).* It held the other five claims in suit, numbers 4, 5, 6, 7, and 8, invalid as showing no invention over Dunham, either alone, or in the light of the Dyer patent (Finding 19), and not infringed on specific grounds enumerated by the Court (Findings 16 and 17, App. 22).

The Court of Appeals affirmed but found it necessary to discuss only the question of validity, upon which it expressly agreed with the District Court both that claim 1 was anticipated by Dunham and that the other claims showed no invention over Dunham (Pet. p. 16).

Neither the District Court nor the Court of Appeals found it necessary to consider the scope or the effect of Section 103 of the Patent Act of 1952 upon earlier decisions of this Court. Petitioner's presentation of the question of interpretation of Section 103 is purely academic and bears in no way upon the determinations made in this case by the trial and appellate courts that one claim was clearly anticipated and the others showed no invention.

The Petition admits that there is no conflict between the circuits (p. 2), and it points out no other considerations that might qualify the decision of this case as one warranting the grant of the writ of certiorari under Rule 19(b).

* The "Questions Presented" in the Petition do not reach this claim (Pet. p. 9).

Petitioner's real objective is exposed in its complaint (Pet. p. 9) as to the manner in which Respondent proved its case.

As the Findings of the District Court (App. 18-25) and the opinion of the Court of Appeals (Pet. 11-19) clearly disclose, both courts applied only the most elementary and indisputable principles of patent law to facts found by the trial court upon conflicting testimony.

ARGUMENT.

1. The Petition Fails to Make Out Even a Prima Facie Case for Review by Certiorari.

Besides the complete absence from the case of any of the considerations prescribed by Rule 19(b) as warranting the grant of the writ of certiorari, the Petition presents a situation where the review sought by Petitioner would in any event be futile.

Petitioner's argument is directed entirely to an effort to procure a review by this Court of the ruling that Castner claims 4 to 8, inclusive are invalid because they lack invention over the Dunham patent.* These claims were also all held not infringed (Findings 16-17, App. 22). Petitioner does not challenge the finding of non-infringement, a finding made upon conflicting testimony, and conclusive under Federal Rule 52(a).

Thus, were the Petition to be granted, and the "Questions Presented" therein even answered in Petitioner's favor, the judgment would be nevertheless undisturbed because of the fatal consequence of the judgment of non-infringement.

* While Petitioner represents that the conclusion of non-invention was reached by combining Dunham and Dyer (Pet. p. 9), a practice obviously available under Section 103, both the District Court expressly, and the Court of Appeals impliedly and by affirmance, held that there was no invention in the light of

2. Petitioner's Argument Addressed to Sections 103 and 282 of the Patent Act of 1952 Is Completely Without Merit.

While the Petition pretends to present an issue for determination by this Court as to the meaning and scope of Sections 103 and 282 of the Patent Act of 1952, it fails to point out anything done or said by either the trial or appellate court in this case which could be construed as an attempted interpretation of these provisions of the law. The Petition raises a wholly academic issue as to the meaning of these sections, based upon statements by other courts in other cases, and law review commentaries, with none of which the courts deciding this case have, even inferentially, differed.

The Court of Appeals did refer to Section 103 (Pet. p. 16) and in the very terms of the Section held that "the prior art * * * taught them (the patentees) all that they, as skilled mechanics, needed to be taught in order to do what they accomplished." Developments involving only mechanical skill have never been patentable under any standard of invention ever applied.

Nor does Petitioner point out in what respect the Courts below might have erred in reaching their conclusion of non-invention, regardless of the standard of invention employed.

Petitioner fails to point out to this Court that Petitioner itself, in seeking the reissue of its patent, under its patentee's oath, told the Patent Office that its patent was inoperative over the Dunham reference (which the Patent Office had not cited on the examination of the original Castner application) and then accepted from the Patent Office the Reissue patent in suit, with three added claims, the specification changed only by the addition of the itali-

cized paragraph appearing in the Reissue patent (App. 455). See Finding 21, App. 23-24.

Manifestly, the "Questions Presented" by the Petition are not present in this case.

CONCLUSION.

The Petition for Writ of Certiorari presents a purely academic question, not present in this case, and should be denied.

Respectfully submitted,

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August 27, 1957.

ACKNOWLEDGMENT OF SERVICE.

I, Edward C. Grelle, hereby acknowledge receipt of copies of Respondent's Brief in Opposition to Petition for Writ of Certiorari on this 27th day of August, 1957.

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